

### Remarks

#### **Claim Status**

Claims 1-89 were presented for examination. Claims 1-12, 14-18, 27-39, 41-46 and 83-88 have been withdrawn pursuant to a restriction requirement. By this response, claims 13, 40, 70-80 and 89 have been cancelled without prejudice to Applicant's right to seek patent protection on those claims at a later date. Claims 19, 21, 23-26, 47, 49, 51, 52, 54-57, 59 and 62-65 have been amended.

After entry of this amendment, Claims 19-26, 47-69 and 81-82 remain pending in the Application.

#### **Amendments to the Claims**

Independent claims 19 and 47 have been amended to recite that the textured or roughened insert has first and second ends that can contact one another to form a seam, and first and second edges between the first and second ends.

Claims 21, 49 and 59 have been amended to overcome the informalities mentioned by the Examiner.

Claim 23 has been amended to recite that the retaining means contacts the first and second edges. Claims 51 and 52 have been amended in a similar manner to recite that the first and second edges of the sleeve are contacted by the frame member; that the frame member is connected to the display surface (claim 51) and that the frame member extends a predetermined distance from the display surface (claim 52).

Claim 25 has been amended to recite that the textured or roughened surface comprises a **random** set of features.

Claims 54-56 have been amended to make their language consistent with claim 47 with regard to the "ends".

Independent claim 57 has been amended to recite that the textured or roughened insert has a surface that comprises a **random** collection of features. It has further been amended to recite that the insert has first and second ends that can contact one another to form a seam, and first and second edges between the first and second ends.

Claims 13, 40, 70-80 and 89 have been cancelled. Accordingly it is submitted that the rejections of all of these claims have been rendered moot.

Claims 62-64 have been amended to make their language consistent with claim 57 with regard to the “ends”.

Independent claim 65 has been amended to recite that the insert has first and second ends that can contact one another to form a seam, and first and second edges between the first and second ends. It has been further amended to recite that the first and second ends extend into a recess in the base layer by a predetermined distance.

These amendments are fully supported by the application. Their entry is courteously requested.

### **Examiner's Objections**

The Examiner has objected to the specification because the first paragraph refers to application Serial No. 09/566,363 as a pending unpublished application that is related to the present invention when the appropriate Serial No. should be 09/566,063. Applicant has amended the specification to correct this typographical error.

Claims 21, 49 and 59 have been objected to because of the use of certain terms that the Examiner regards as informal. Applicant has amended these claims as suggested by the Examiner to overcome this objection.

### **Claim Rejections – 35 U.S.C. § 112**

Claims 13, 40 and 89 have been rejected under Claim Rejections – 35 U.S.C. § 112, second paragraph for being dependent upon withdrawn claims. Applicant has cancelled claims 13, 40 and 89. Accordingly, this rejection has been rendered moot.

### **Claim Rejections – 35 U.S.C. § 102**

Pending claims 19-26, 47-54, 65-69 and 89 are rejected under 35 U.S.C. § 102(e) as being anticipated by Guest (U.S. 6,490,093). Applicant submits that these claims are not anticipated by this reference.

Guest discloses a method of protecting an ink layer during molding of a lenticular lens into plastic objects. Guest does not disclose that the insert to be used in this method has first and second ends for contact to one another to form a seam. To the contrary, Guest discloses that the

insert is held in place by a frame that surrounds the insert. Thus, the ends of the insert are kept apart from one another by the frame and cannot come into contact with one another. See Column 9, lines 16-40. Therefore, Guest does not anticipate any of claims 19-26 and 47-54.

Pending claims 19-21, 23 25-26, 47-49 51, 53, 65-67 and 69 are rejected under 35 U.S.C. § 102(e) as being anticipated by Goggins (U.S. 6,635,196). Applicant submits that these claims are not anticipated by this reference.

Goggins discloses molded articles that have a surface bearing a lenticular image. Goggins is silent with regard to the relationship of the ends of the insert once the insert is formed into a final product. All that Goggins says on this point is that the insert is typically sized as a flat piece that is shaped to cover substantially the entire outer surface of the finished cup. As a result, Goggins does not teach that the ends of the insert are for contact with one another to form a seam. Therefore, Applicant submits that these claims are not anticipated by this reference.

Pending claims 57-59, and 61-61 are rejected under 35 U.S.C. § 102(e) as being anticipated by Goggins II (U.S. 6,490,092). Applicant submits that these claims are not anticipated by this reference.

Goggins II discloses methods for preparing and applying an interlaced image onto a curved surface. Goggins II is silent with respect to an insert that has a textured or roughened surface comprising a random collection of features. As a result, Goggins II does not anticipate these claims.

### **Claim Rejections – 35 U.S.C. § 103**

Pending claims 54-56 and 81-82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goggins. Applicant submits that these claims are patentable over this reference.

Goggins is silent with regard to the relationship of the ends of the insert once the insert is formed into a final product. As a result, Goggins provides no reason to provide this feature in its articles. Therefore, Applicant submits that Goggins does not support the rejection of claims 54-56 under 35 U.S.C. § 103(a).

With regard to claims 81-82, Applicant submits that the mere fact that Goggins may teach that various components can be used does not support the Examiner's rejection. Nothing in Goggins suggests the multi-layer construction of these claims. The mere disclosure of one of the layers used in Applicant's claim is not a general disclosure of the other layers, what they

should do, or how they should be arranged in the construction. Goggins simply does not support the rejection of these claims.

Claims 55-56 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Guest. Applicant submits that it has been shown that claim 47 is not anticipated by, and is therefore patentable over, Guest. He submits that claims 55-56 are likewise patentable over Guest as they are dependent upon claim 47, a patentable claim.

Claims 60 and 63-64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goggins II in view of Guest. Applicant submits that it has been shown that claim 57 is not anticipated by, and is therefore patentable over, Goggins II. He submits that claims 60 and 63-64 are likewise patentable over Guest as they are dependent upon claim 57, a patentable claim.

### Conclusion

It is respectfully submitted that the present claims are now in condition for allowance, and early notice to that effect is earnestly solicited. In the event that a phone conference between the Examiner and the Applicants' undersigned attorney would help resolve any remaining issues in the application, the Examiner is invited to contact the attorney at (651) 275-9844.

Respectfully Submitted,

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